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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,762	10/16/2003	Edward W. Gross	5175-155	8686
20792	7590	11/30/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			HAYES, BRET C	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,762

Applicant(s)

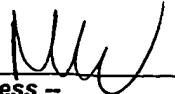
GROSS ET AL.

Examiner

Bret C Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 3, 8 – 12, 16 – 21 and 24 – 29 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,032,612 to Williams.

3. Re – claim 1, Williams discloses the claimed invention including an *in ovo* injection apparatus 10, comprising: an egg carrier 15 that holds a plurality of eggs 20 and provides external access to the eggs 20; a plurality of injection devices 25 positioned above the carrier 15, wherein each injection device 25 is configured to contact a respective egg 20 in the carrier and deliver a predetermined dosage of a treatment substance into the egg 20 and/or remove material from the egg 20; and an egg support assembly, see Fig. 10, for example, positioned beneath the carrier 15 that is configured to support each egg 20 in the carrier 15 during contact therewith by a respective injection device 25.

4. Re – claim 2, Williams further discloses wherein the egg support assembly comprises: *a frame, see Fig. 1, for example, movable between an operative position and a retracted position; a plate, best seen in Fig. 2, for example, attached to the frame and comprising an array of openings formed therein; and a plurality of pedestals, each pedestal removably secured within a respective one the openings, wherein each pedestal comprises a free end portion 26 configured to engage an egg 20 within the carrier 15 when the frame in the operative position. *Regarding this rejection,

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Williams discloses, as best seen in Fig. 10, pedestals contacting the egg from both above and below. Williams does not explicitly state the construction of the lower egg support assembly. However, since Williams discloses that alteration of the device would be necessitated by injecting from both above and below, set forth at col. 9, line 51, it would be fair to take the disclosed structure of the upper assembly as a guide for the lower assembly.

5. Re – claim 3, Williams further discloses wherein the egg support assembly is operatively associated with the plurality of injection devices **25** such that each pedestal moves upwardly through a respective opening in the carrier **15** to support an egg **20** as a respective injection device **25** makes contact with the egg **20**.

6. Re – claim 8, Williams further discloses wherein each pedestal free end portion **26** having a concave configuration.

7. Re – claim 9, Williams further discloses wherein each pedestal free end portion **26** comprises a wall inclined relative to a centerline of the pedestal between 25° and 55°.

8. Re – claim 10, Williams further discloses wherein the frame is movable via an actuator, see bottom of Figs. 1 and 2, for example.

9. Re – claims 11 – 12, 16 – 20, 24 and 25, Williams as applied above, discloses the claimed invention.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5 – 7, 13 – 15, 22, 23, 26, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams as applied above.

12. Re – claims 5, 6, 13, 14 and 22, Williams discloses the invention substantially as claimed as applied above. However, Williams does not disclose wherein a height of the free end portion of each pedestal relative to the plate is adjustable, and wherein the height of the free end portion of each pedestal relative to the plate is adjustable via one or more shims disposed between the free end portion and the plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust a height, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954). Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use shims to adjust the height, since it was known in the art that shims are commercially available and have been used to adjust height in and make level constructions of all kinds. At Applicants request, examiner will provide prior art support.

13. Re – claims 7, 15 and 23, Williams discloses the invention substantially as claimed as applied above, including wherein each pedestal includes a proximal end portion 27 opposite from the free end portion 26 and the pedestal being fastened within a respective plate opening, see Figs. 1 and 2, for example. However, Williams does not disclose wherein an O-ring is secured to the proximal end of the pedestal that provides a snug, friction fit when the proximal end is disposed within a respective one of the plate openings. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an O-ring that is secured to the proximal end of the pedestal that provides a snug, friction fit, since the

equivalence of any means for fastening and an O-ring for their use in the friction fitting art and

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the selection of any known equivalents to an O-ring would be within the level of ordinary skill in the art. At Applicants request, examiner will provide prior art support.

14. Concerning method claims 26, 27 and 29 in view of the structure disclosed by Williams, the method of operating the device would have been inherent, since it is the normal and logical manner in which the device could be used.

15. Claims 4, 21 and 28 are rejected under 35 U.S.C. § 103 as being unpatentable over Williams in view of US Patent No. 4,040,388 to Miller.

16. Re – claims 4 and 21, Williams discloses the invention substantially as claimed as applied above. However, Williams does not disclose the egg support assembly is configured to lift each egg from the carrier during contact with each egg by a respective injection device.

17. Miller teaches an egg support assembly 22 configured to lift each egg 14 from a carrier 10 during contact with each egg 14 by a respective injection device 60 in the same field of endeavor for the purpose of injecting *in ovo*. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Williams to include the lifting device as taught by Miller in order to inject *in ovo*.

18. Concerning method claim 28, in view of the structure disclosed by Williams in view of Miller, the method of operating the device would have been inherent, since it is the normal and logical manner in which the device could be used.

Response to Arguments

1. Applicant's arguments filed 16 SEP 2004 have been fully considered but they are not persuasive.

2. Applicant argues that examiner is confused about the Williams reference, stating:

“The action is confusing an injection device **25'** that is configured to inject an egg from the bottom of the egg with a support pedestal of the present invention. The egg engaging member **26** does not serve the function of a support that is configured to support an egg against the opposing force of an injection device. Nothing in Williams teaches or suggests supporting an egg against the opposing force of injection device **25** with the injection device **25'**. Fig. 10 of Williams is merely provided to show that multiple injection devices may be utilized and/or an injection device may be utilized at different locations relative to an egg. As viewed by the ordinary artisan, there is a great difference between a support pedestal of the present invention and the injection device **25'** of Williams.

Moreover, Applicants respectfully assert that the injection device **25'** of Williams teaches away from supporting an egg during injection. The egg engaging member **26** of the injection device **25'** is slidably connected to the body member of the injection device **25'**. Such a configuration cannot support an egg against downward forces caused during injection by an injection device located on top of an egg.” *(Examiner’s emphasis added.)*

Examiner disagrees. As viewed by an ordinary artisan, Williams’ injection devices **25'**, such as in FIG. 10, include the claimed support pedestal, such as **26**, whether Williams is *merely* showing that multiple devices may be utilized or not. In other words, there is no structural or functional difference between the claimed support pedestal and the Williams’ pedestal **26** of FIG. 10. Williams’ pedestal solidly supports an egg and prevents it from being pushed downwardly into the carrier by a[n]...injection device as claimed. If not, the descending injection devices of FIG. 10 would be unable to perform.

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Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (703) 305 – 7421. The fax number is (703) 872 – 9306.

bh

11/28/04



**TERI PHAM LUU
SUPERVISORY
PRIMARY EXAMINER**